REMARKS

Claims 1-34 are pending in the application.

Claim 1 has been amended. Claims 2-34 are added. Support for the amendment to claim 1 can be found throughout the specification, for example, col. 4, lines 6-12, Table 1, and col. 5, lines 45-46. No new matter has been added by this amendment. Support for new claims 2-34 can be found throughout the specification. No new matter has been added by these new claims. Reconsideration is respectfully requested in light of the foregoing amendment and the remarks that follow.

I. DOUBLE PATENTING

The examiner rejects claim 1 based on 35 U.S.C. §101, double patenting of the "same invention" type which finds its support in the language of which states that "whoever invents or discovers any new and useful process ... may obtain patent therefor ... (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 §U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 §U.S.C. 101. Claim 1 is rejected under 35 §U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,713,738. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-

type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., in re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); in re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); in re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); in re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thoringion, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

The examiner also rejects claim on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,361,320. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to use an argon laser as it is a known source of light having a wavelength between 450-530 nanometers.

The examiner further rejects claim 1 on the ground of nonstatutory double patenting over claim 20 of U. S. Patent No. 5,645,428 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The claim of the patent "anticipates" the claim of the application. Accordingly, the application claim is not patentably distinct from the patent claim. Here, the more specific patent claim encompass the broader application claim. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown

to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Applicants respectfully traverse the rejection.

Claim 1 has been amended. Applicant believes the amendment renders the same invention double patenting rejection of claim 1 under 35 §U.S.C. 101 moot.

As for the judicially created double patenting rejection of claim 1, Applicant respectfully request reconsideration of the rejection based on the amendment submitted.

Reconsideration is respectfully requested.

II. CONCLUSION

The applicant believes that this Amendment addresses all of the points raised in the Office Action, and requests reconsideration and allowance of the present application.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact the undersigned at 310-845-8501.

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Respectfully submitted,

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